## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/516972 Published in the Official Gazette on March 23, 2004

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QUAD INT'L, INCORPORATED,	:	U.S. Patent & TMOfc/TM Mail Rept Dt. #78
	:	Opposition No.:
Opposer,	:	
	:	<b>CERTIFICATE OF MAILING</b>
vs.	:	I hereby certify that on April 7 2004, this paper is being
	:	deposited with the U.S. Postal Service by "Express Mail Post
ANDREA FISCHER,	:	Office to Addressee" service with Express Mail Label No.
	•	ER 517725254 US, for delivery to the Commissioner for
	•	Trademarks, BOX TTAB FEE, 2900 Crystal Drive, Arlington,
	:	VA, 22202-3513.
Applicant.	:	aure
		I AIR A FERNANDEZ

### **NOTICE OF OPPOSITION**

Opposer, QUAD INT'L, INCORPORATED, ("Opposer"), believes it will be damaged by registration of the mark shown in Application Serial No. 76/516972, filed on May 19, 2003 and published on March 23, 2004, and hereby opposes same. As grounds for opposition, Opposer alleges as follows:

### THE PARTIES

- 1. Opposer is a corporation organized and existing under the laws of the State of Florida, with its principal place of business in Miami, Florida. Opposer is a leader in the adult publishing industry through its adult print magazines, adult websites and web publications, and adult videos and DVD production.
- 2. Upon information and belief, Applicant ANDREA FISCHER ("Applicant") is an individual residing in Germany. Applicant is a former model for Opposer's various print publications and Internet websites.

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### **OTHER ALLEGATIONS OF FACT**

- 3. Opposer invented, created, conceived of and originated the fictitious name and character "Chloe Vevrier" in 1992, and featured the character in Opposer's print magazine as early as 1992. At least as early as January of 1993, Opposer used the name "Chloe Vevrier" in a publication entitled "The best of SCORE," one of the Opposer's print publications. This magazine featured the Applicant under the name the Opposer conceived of and created, "Chloe Vevrier."
- 4. Since that time and until the present, Opposer has continuously and without interruption used the fictitious name and character "Chloe Vevrier" in promoting its adult magazines featuring the Applicant. Beginning in January of 1998, Opposer also began to feature the fictitious name and character "Chloe Vevrier" on its adult websites. On or about July 22, 1998, Opposer launched a website using the mark CHLOESWORLD, with <a href="https://www.choloesworld.com">www.choloesworld.com</a> as its web address, and featuring a website dedicated exclusively to photographs and information relating to fictitious character it created, Chloe Vevrier. Excerpts of the "chloesworld" website are attached hereto as Exhibit "A."
- 5. Opposer is the owner of the "chloesworld" website and since that website was launched in 1998 to the present, Opposer has continuously and without interruption used the mark CHLOESWORLD in promoting its website featuring the Applicant. In fact, on or about April 18, 2001, Opposer filed an application with the United States Patent and Trademark Office to register the mark "CHLOESWORLD," Serial No. 76/242110, in Class 41, in connection with "entertainment services, namely, providing adult material and viewing thereof, including images and editorial content in the area of adult entertainment and subject matter, all offered electronically." Although this application was abandoned, Opposer still extensively uses and

promotes the mark "CHLOESWORLD." In addition, Opposer recently filed another application for the mark CHLOESWORLD, in Class 41, Serial No. 78/397250, in connection with "entertainment services, namely providing adult material and viewing thereof, and providing images and editorial content in the field of adult entertainment via a global computer network."

- 6. Opposer has extensively advertised and promoted the mark "CHLOESWORLD" and the fictitious character it created, "Chloe Vevrier." Opposer expends approximately \$60,000.00 per year throughout the United States in promoting the mark "CHLOESWORLD" and the fictitious character it created, "Chloe Vevrier."
- 7. The printed material and websites published and produced by Opposer featuring the character Chloe Vevrier and/or the mark CHLOESWORLD are well and favorably known to the trade and to the public in United States, as well as in foreign countries, and are understood as originating with, and/or being affiliated with Opposer.
- 8. By virtue of the long, extensive and continuous use by Opposer of the character Chloe Vevrier and/or the mark CHLOESWORLD, and the efforts and expenditures of Opposer to advertise and promote their goods and services thereunder, the name Chloe Vevrier and the mark CHLOESWORLD have become assets of substantial value to Opposer.
- 9. On or about May 5, 2003, Applicant filed Application Serial No. 76/516972 to register the mark "CHLOE VEVRIER" in Class 41 in connection with "Entertainment services in the nature of providing a website on the global computer networks featuring information in the field of adult entertainment; providing an online website of information comprising of adult material and viewing thereof; and other adult entertainment related news, facts, trivia and humor."

- 10. The services recited in Applicant's application are identical or substantially similar to those offered by Opposer under the mark CHLOESWORLD, and under the fictitious name it created, Chloe Vevrier. Applicant offers these services through a global computer network using the web address <a href="www.chloevevrier.com">www.chloevevrier.com</a>, just as Opposer does through its website <a href="www.choloesworld.com">www.choloesworld.com</a>. Moreover, Applicant's mark and Opposer's mark CHLOESWORLD both use the name "Chloe" and the content of both websites depicts the same character created by Opposer under the fictitious name Chloe Vevrier. Excerpts from Applicant's website are attached hereto as Exhibit "B" and appear similar to that of Opposer's website, attached hereto as Exhibit "A." Applicant's services and Opposer's goods and services are marketed to the same customers.
- 11. Applicant was a former model for Opposer, and, in fact, entered into several agreements with Opposer regarding the use of her likeness and images in print and electronic media, under the fictitious name created by Opposer, Chloe Vevrier. Any use associated with the name "Chloe Vevrier" by the Applicant inured to the benefit of Opposer, the inventor and creator of the name and character.
- 12. Applicant filed Application Serial No. 76/516972 with full knowledge and in complete disregard of Opposer's rights in the name "Chloe Vevrier" and the mark CHLOESWORLD, and in a deliberate and improper attempt to usurp those rights. As a result, Applicant knowingly misled and/or made an incorrect statement regarding her ownership and exclusive use of the mark CHLOE VEVRIER in the declaration accompanying the Application.
- 13. Applicant's mark CHLOE VEVRIER, as applied to the services set forth in Applicant's application, so resembles Opposer's previously used mark CHLOESWORLD, and

the name it invented and has continually and previously used for more than a decade, "Chloe Vevrier," to cause confusion or to cause mistake or to deceive consumers.

- 14. Purchasers of Applicant's services are likely to believe that those services originate with or are sponsored by Opposer.
- 15. Based upon the foregoing, the registration of the mark depicted in Application Serial No. 76/516972, filed on May 19, 2003 on the Principal Register of the United States Patent and Trademark Office, will cause injury and damage to Opposer.

# <u>COUNT I</u> (Likelihood of Confusion with Previously Used Mark)

- 16. Opposer repeats and realleges the allegations in preceding paragraphs 1-15, inclusive, as if fully set forth herein.
- 17. Applicant's mark shown in Application Serial No. 76/516972 so resembles

  Opposer's previously used mark CHLOESWORLD, and the name it invented and has

  continually and previously used and promoted for more than a decade, "Chloe Vevrier," to cause

  confusion or to cause mistake or to deceive consumers.
- 18. Opposer will be damaged by registration of the Applicant's mark because the registration will give Applicant prima facie evidence of the validity of its confusingly similar mark and of the exclusive nationwide rights to use its confusingly-similar mark in commerce in connection with the services identified in Application Serial No. 76/516972, in degradation of the rights of Opposer in its CHLOESWORLD mark and in the name it invented and has continually and previously used and promoted for more than a decade, "Chloe Vevrier."

## <u>COUNT II</u> (False or Misleading Designation of Origin)

- 19. Opposer repeats and realleges the allegations in preceding paragraphs 1-18, inclusive, as if fully set forth herein.
- 20. Applicant's use of CHLOE VEVRIER in connection with services identified in Application Serial No. 76/516972 constitute a false designation of origin, or a false representation that Applicant's services are in some way sponsored by or associated with Opposer.
- 21. Applicant has offered such services with knowledge of the falsity of such designation of origin or representation.
- 22. Opposer will be damaged by registration of the Applicant's mark because purchasers of Applicant's services are likely to believe that those services originate with or are sponsored by Opposer, when, in fact, they are not.

## COUNT III (Applicant is Not Using Mark as a Trademark)

- 23. Opposer repeats and realleges the allegations in preceding paragraphs 1-15, inclusive, as if fully set forth herein
- 24. The name "CHLOE VEVRIER" for which registration is sought by Applicant has not been used as a trademark or service mark.
- 25. The name "CHLOE VEVRIER" merely serves as a fictitious name which was invented, created, conceived of, originated by and promoted and advertised by Opposer, not Applicant.

26. Opposer will be damaged by registration of the Applicant's mark because the registration will give Applicant prima facie evidence of ownership and of the exclusive nationwide rights to use the name CHLOE VEVRIER, in degradation of the rights of Opposer in its CHLOESWORLD mark and in the name it invented and has continually and previously used and promoted for more than a decade, "Chloe Vevrier."

# **COUNT IV**(Fraud on the Patent and Trademark Office)

- 27. Opposer repeats and realleges the allegations in preceding paragraphs 1-15, inclusive, as if fully set forth herein.
- 28. Applicant had a duty not to make knowingly inaccurate or knowingly misleading statements in the verified declaration accompanying the application for registration of the mark CHLOE VEVRIER.
- 29. Applicant filed Application Serial No. 76/516972 with full knowledge and in complete disregard of Opposer's rights to use name "Chloe Vevrier" and the mark CHLOESWORLD, and in a deliberate and improper attempt to usurp those rights. As a result, Applicant knowingly misled and/or made an incorrect statement regarding her ownership and exclusive use of the mark CHLOE VEVRIER in the declaration accompanying the Application.
- 30. Opposer will be damaged by registration of the Applicant's mark because the registration will give Applicant prima facie evidence of ownership and of the exclusive nationwide rights to use the name CHLOE VEVRIER, in degradation of the rights of Opposer in its CHLOESWORLD mark and in the name it invented and has continually and previously used and promoted for more than a decade, "Chloe Vevrier."

WHEREFORE, Opposer requests that registration of Applicant's mark CHLOE VEVRIER, Application Serial No. 76/516972, be denied and that this Opposition be sustained.

Opposer, QUAD INT'L, INCORPORATED, hereby appoints, Richard A. Morgan, Laura Fernandez, and Michael L. Dever (United States Patent and Trademark Office Registration No. 32,216), of Buchanan Ingersoll Professional Corporation, its attorneys in the matter of the above-identified Opposition, to prosecute the Opposition, to transact all business with the Patent and Trademark Office and the United States courts connected with this Opposition and to sign its name to all papers which may hereafter be filed in connection with the Opposition and to receive the official communications relating to the same.

Date\_

Date 47/04

QUAD INT'L, INCORPORATED

By Name Land Solice

Title: Director of

Richard A. Morgan, Esq.

Laura Fernandez, Esq.

BUCHANAN INGERSOLL, P.C.

100 Southeast Second Street, Suite 2100

Miami, Florida 33131

Telephone: (305) 347-4080 Facsimile: (305) 347-4089

Michael L. Dever, Esq.

Reg. No. 32,216

BUCHANAN INGERSOLL, P.C.

One Oxford Centre

301 Grant Street, 20th Floor

Pittsburgh, PA 15219-1410

Telephone: (412) 562-1635

Facsimile: (412) 562-1041

Attorneys for Opposer QUAD INT'L, INCORPORATED

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EXHIBIT "A

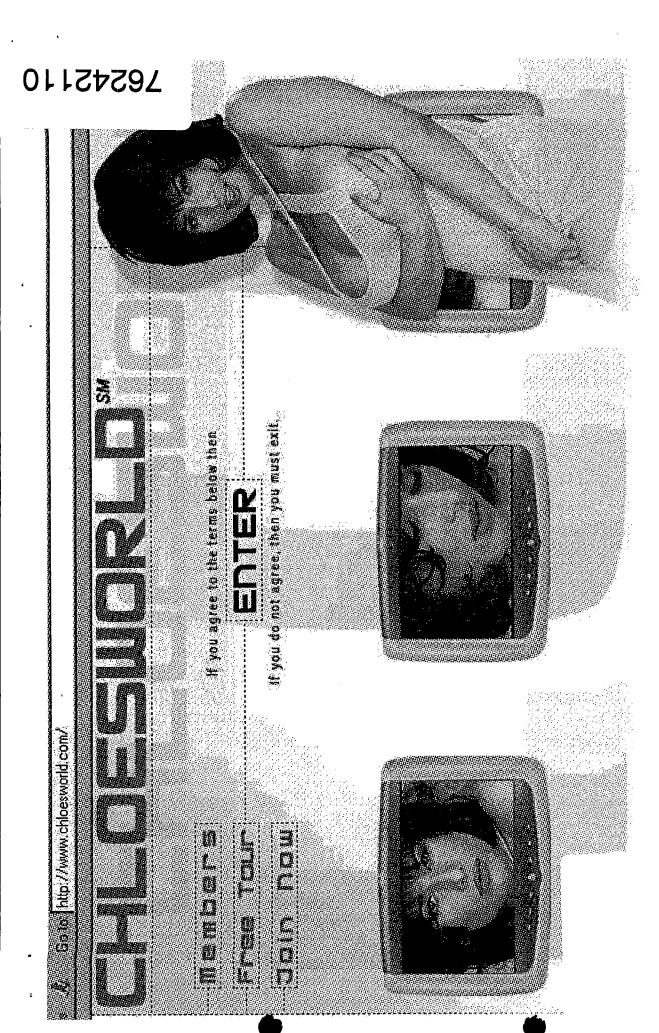
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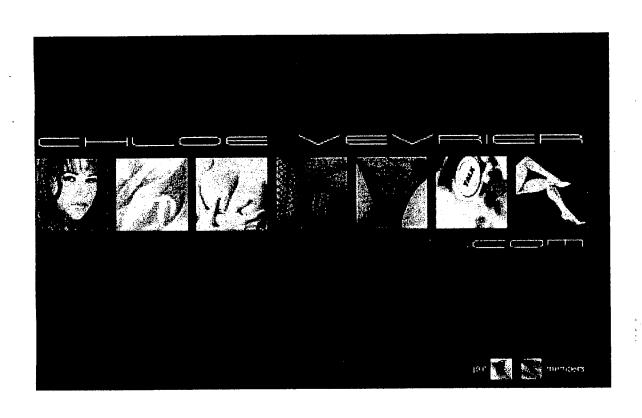
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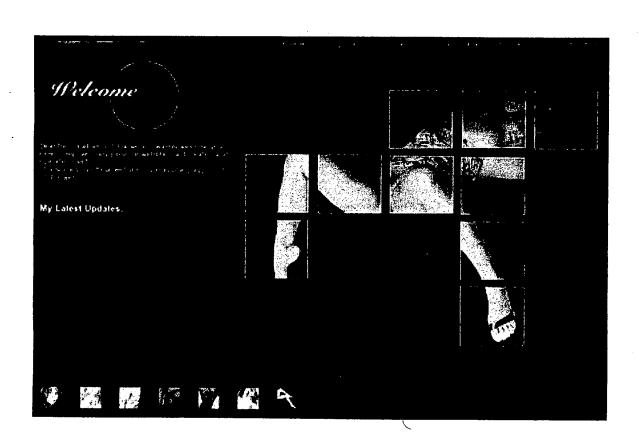
The ChloesWorld.com Internet web site contains sexually oriented adult material intended for individuals 18 years of age or older. By entering this site, you are certifying that you are of legal adult age and downloading the images in this web site do not violate the community standards of your street, village, city, town, state, county, or country. You also certify that you are wholly liable for any false disclosures, and responsible for any legal material contained herein. Certificate of Compliance Records relating to any images on this site required to be maintained by 18 U.S.C. \$2257 (a) ramitications that may arise from reading, viewing or downloading of images or material contained within this web site. The Score Group and its affiliates can not be held responsible for any legal ramifications that may arise as a result of fraudulent entry into or use of this web site and/or

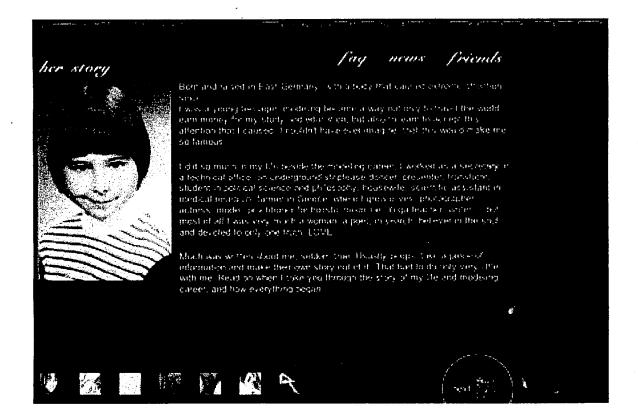


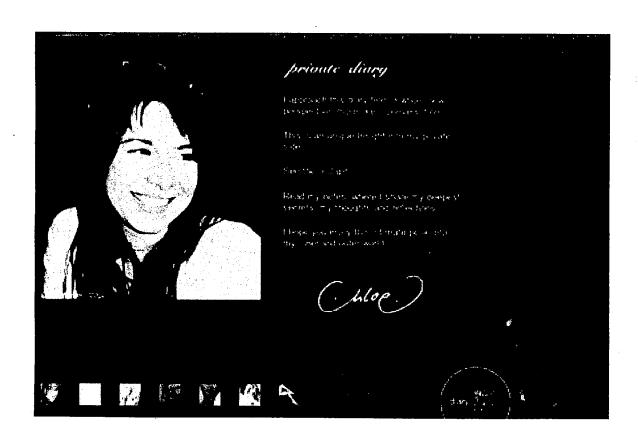
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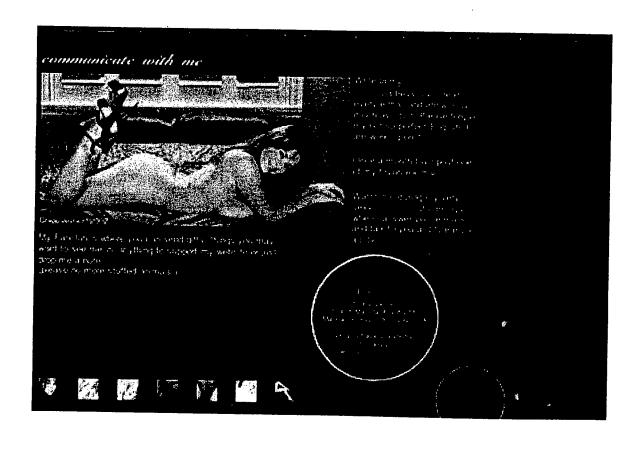
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# Buchanan Ingersoll

Laura Fernandez (305) 347-4096 fernandezl@bipc.com Bank of America Tower 100 S.E. Second Street, Suite 2100 Miami, FL 33131-2150

T 305 347 4080 F 305 347 4089

www.buchananingersoll.com

April 7, 2004



04-07-2004

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #78

EXPRESS MAIL NO: ER517725254US

Box TTAB/FEE Commissioner for Trademarks 2900 Crystal Drive Arlington, Virginia 22202-3513

Re:

Notice of Opposition for CHLOE VEVRIER (Serial No. 76/516972)

(Published on March 23, 2004)

Dear Sir or Madam:

Enclosed for filing please find an original and two duplicates of a Notice of Opposition for the above-referenced mark. Also enclosed is a check in the amount of \$300.00 representing the filing fee for the Notice of Opposition.

Also attached is a self-addressed stamped acknowledgment card. Please stamp the card to acknowledge receipt and return the card to me. Thank you.

If you have any questions or need additional information, please contact me at (305) 347-4096.

**Enclosures** 

cc:

Lawrence Iyoho

Richard A. Morgan, Esq.